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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/541,307 | 04/10/2006 | Jochen Ackerman | 273100US0PCT | 8081 |
| 22850 | 7590 | 10/26/2007 | EXAMINER | |
| OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | CHO, JENNIFER Y | |
| ART UNIT | | PAPER NUMBER | | |
| 1621 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 10/26/2007 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | |
|------------------------------|-----------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/541,307 | ACKERMAN ET AL. |
| | Examiner Jennifer Y. Cho | Art Unit 1621 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 August 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 - 5) Claim(s) _____ is/are allowed.
 - 6) Claim(s) 1-19 is/are rejected.
 - 7) Claim(s) _____ is/are objected to.
 - 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 05 July 2005 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Receipt is acknowledged of the Response filed 8/13/2007.

Claims 1-19 are considered to be the elected invention.

Response to Arguments

Applicant's amendment filed 8/13/2007 is sufficient to overcome the claim objections of the previous office action. Therefore, the objection has been withdrawn.

Claim Rejections – 35 USC 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3 and 7-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no evidence in the record for the amended claim language of "first portion, second portion, third portion and fourth portion", at the time of filing the application.

Claim Rejections – 35 USC 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in regards to the second portion and the fourth portion of the bottom effluent. The claims do not set forth any steps for the second and fourth portion that are involved in the process, and it is unclear in the claim language what the applicant is intending to encompass by dividing the bottom effluent into several portions. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections – 35 USC 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-6, 10-12 and 16-19 remain rejected under 35 U.S.C. 102(e) as being anticipated by Geisendoerfer et al. (US Patent Publication 2004/0171868 A1). For reasons, see previous office action and responses stated herein.

Claim Rejections – 35 USC 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Geisendoerfer et al. (US Patent Publication 2004/0171868 A1). For reasons, see previous office action and responses stated herein.

Response to Arguments

Applicant's arguments have been considered but are not persuasive for the following reasons:

The Examiner acknowledges Applicant's argument that Geisendoerfer et al. does not disclose that the bottom products are recycled to a reaction apparatus, but subjected to a residue work-up. The applicant also states that as a result the catalyst

may be recycled in an inactive form and the superfluous effort for separation could significantly increase production costs.

The Examiner asserts that applicant's open "comprising" claim language allows for intermediate steps of the bottom products before being recycled to a reaction apparatus. Geisendoerfer et al. does subject the bottom products to further work-up, but then in preferred embodiments, the bottom product is recycled back to a reaction apparatus (see page 9, section 194 and 199). As far as applicant's assertion for the drawbacks of intermediate steps with regard to cost and catalyst activity, it is the burden of the applicant to substantiate these arguments with regards to unexpected results or criticality. Otherwise it would be *prima facie* obvious for one of ordinary skill in the art to use and recycle an active catalyst, not an inactive one, in the transesterification reaction, and to lower production costs and increase yields, through optimization.

The Examiner acknowledges Applicant's argument that Geisendoerfer et al. does not disclose or suggest selectively recycling particular portions of the bottom effluent from the film evaporator and/or vacuum evaporation stage.

The Examiner agrees with this statement. However, the claims are not drawn to **selective** portions of the bottom effluent and thus are not commensurate in scope with the claim language. The applicant has not described in the claim language how the portions are selected and divided, but merely to varying weight percentages for the first portion of the bottom effluent.

The Examiner acknowledges Applicant's argument that Geisendoerfer et al. does disclose and suggest that a portion of a bottom effluent from a film evaporator and/or vacuum evaporation stage is recycled to a reaction apparatus.

The Examiner interprets the art's statement of "this bottom mixture to be recycled partly, preferably in an amount of 60-95%, into the transesterification..." (page 8, section 170, line 1-2) and "the bottom product, mainly comprising remaining desired ester, Michael adducts, stabilizer and polymers, can be fed at least partly..." (page 8, section 189, lines 1-3), as dividing the bottom effluent into a first portion and a second portion.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Y. Cho whose telephone number is (571) 272 6246. The examiner can normally be reached on 9 AM - 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on (571) 272 0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jennifer Cho
Patent Examiner
Art Unit: 1621



FOR

Yvonne Eyler
Supervisory Patent Examiner
Technology Center 1600